



0172.39340X00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Janne KALLIO
Serial No.: 09/770,491
Filed: January 29, 2001
For: **GSM NETWORKS AND SOLUTIONS FOR PROVIDING
SEAMLESS MOBILITY BETWEEN GSM NETWORKS AND
DIFFERENT LOCAL RADIO NETWORKS**
Group: 2683
Examiner: D Agosta, Stephen M

**SUPPLEMENTAL RESPONSE – SUBMISSION OF
SUBSTITUTE OF DECLARATION**

Mail Stop Amendment

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

August 20, 2004

Sir:

Further to the Amendment filed on July 30, 2004, in response to the first Office Action (Paper No. 8) dated on March 30, 2004, Applicants attach herewith a substitute declaration identifying the inventor's citizenship.

To the extent necessary, Applicants petition for an extension of time under 37 CFR §1.136. Please charge any shortage of fees due in connection with the filing of this paper, including extension of time fees, to the Deposit Account of Antonelli, Terry, Stout & Kraus, No. 01-2135 (Application No. 0172.39340X00), and please credit any excess fees to said deposit account.

Respectfully submitted,
ANTONELLI, TERRY, STOUT & KRAUS, LLP

By

Hung H. Bui (Reg. No. 40,415)
Attorney for Applicant(s)

HHB:btd
(703) 312-6600
Attachments



Title 37, Code of Federal Regulations, Section 1.56
Duty to Disclose Information Material to Patentability

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by 991.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

(1) Prior art cited in search reports of a foreign patent office in a counterpart application, and

(2) The closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

(1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or

(2) It refutes, or is inconsistent with, a position the applicant takes in:

(i) Opposing an argument of unpatentability relied on by the Office; or

(ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

(c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

(1) Each inventor named in the application;

(2) Each attorney or agent who prepares or prosecutes the application; and

(3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.

(d) Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent, or inventor.

(e) In any continuation-in-part application, the duty under this section includes the duty to disclose to the Office all information known to the person to be material to patentability as defined in paragraph (b) of this section, which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

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Attorney's Docket No. 0172.39340X00

DECLARATION AND POWER OF ATTORNEY FOR PATENT APPLICATION

As a below named inventor, I hereby declare that: my residence, post office address and country of citizenship are as stated below, next to my name; I believe I am the original, first, and sole inventor (if only one name is listed below) or an original, first, and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled: **GSM NETWORKS AND SOLUTIONS FOR PROVIDING SEAMLESS MOBILITY BETWEEN GSM NETWORKS AND DIFFERENT LOCAL RADIO NETWORKS**.

the specification of which

is attached hereto.

X

was filed on January 29, 2001 as

United States Application Number 09/770,491

or PCT International Application Number _____

and was amended on _____

(if applicable)

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claim(s), as amended by any amendment referred to above. I acknowledge the duty to disclose all information known to me to be material to patentability as defined in Title 37, Code of Federal Regulations, Section 1.56.

I hereby claim foreign priority benefits, under 35 U.S.C. 119(a)-(d) or 365(b), of any foreign application(s) for patent or inventor's certificate, or 365(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate, or any PCT international application having a filing date before that of the application on which priority is claimed:

Prior Foreign Application(s)

**Priority
Claimed?**

NONE

(Number)

(Country)

(Foreign Filing Date)

Yes

No

(Number)

(Country)

(Foreign Filing Date)

Yes

No

I hereby claim the benefit, under 35 U.S.C. 119(e), of any United States provisional application(s) listed below:
NONE

(Application Number)

Filing Date

(Application Number)

Filing Date

I hereby claim the benefit, under 35 U.S.C. 120, of any United States application(s) listed below:

(Application Number)

Filing Date

(Status -- patented, pending, abandoned)

(Application Number)

Filing Date

(Status -- patented, pending, abandoned)

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I hereby appoint: Donald R. Antonelli, Reg. No. 20,296; Melvin Kraus, Reg. No. 22,466; William I. Solomon, Reg. No. 28,565; Gregory E. Montone, Reg. No. 28,141; Ronald J. Shore, Reg. No. 28,577; Donald E. Stout, Reg. No. 26,422; Alan E. Schiavelli, Reg. No. 32,087; Carl I. Brundidge, Reg. No. 29,621; Paul J. Skwierawski, Reg. No. 32,173; and Hung H. But, Reg. No. 40,415; of ANTONELLI, TERRY, STOUT & KRAUS, LLP with offices located at 1300 North Seventeenth Street, Suite 1800, Arlington, Virginia 22209, my attorneys, with full power of substitution and revocation, to prosecute this application and to transact all business in the Patent and Trademark Office connected herewith.

Send all correspondence to:

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I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full Name of Sole/First Inventor Janne KALLIO

Inventor's Signature *Janne Kallio* Date 9th August 2004
Residence Heinäkujatie 10, 02140 Pattioki, Finland Citizenship Finnish
(City, State) (Country of Citizenship)
Mailing Address Same as above

Full Name of Second/Joint Inventor _____

Inventor's Signature _____ Date _____
Residence _____ Citizenship _____
(City, State) (Country of Citizenship)
Mailing Address _____

Full Name of Third/Joint Inventor _____

Inventor's Signature _____ Date _____
Residence _____ Citizenship _____
(City, State) (Country of Citizenship)
Mailing Address _____

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